Remarks

The Office action mailed April 12, 2005, has been reviewed and the comments of the examiner carefully considered.

Claims 4 and 7 have been rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness associated with phrase "substantially formaldehyde-free." The Federal Circuit has stated that "[i]t is well established that when the term 'substantially' serves reasonably to describe the subject matter so that its scope would be understood by persons in the field of the invention, and to distinguish the claimed subject matter from the prior art, it is not indefinite." *Verve LLC v. CraneCams, Inc.*, 311 F.3d 1116, 65 USPQ2d 1051, 1054 (Fed. Cir. 2002). The Federal Circuit also explained in *Ecolab Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1367, 60 USPQ2d 1173, 1179 (Fed. Cir. 2001) that "like the term 'about;' the term 'substantially' is a descriptive term commonly used in patent claims to 'avoid a strict numerical boundary to the specified parameter,'" quoting *Pall Corp v. Micron Separations, Inc.*, 66 F.3d 1211, 1217, 36 USPQ2d 1225, 1229 (Fed. Cir. 1995). Thus, contrary to the assertion on page 2 of the Office action, there is no requirement that the claims specify a precise numerical limitation.

Moreover, a person of ordinary skill in the art would understand the meaning of "substantially formaldehyde-free." For instance, the specification on page 11, lines 16-22, describes examples of substantially formaldehyde-free adhesive compositions.

Hence, the 35 U.S.C. §112, second paragraph, rejection of claims 4 and 7 must be withdrawn.

Claims 1-12 and 19-30 have been rejected under 35 U.S.C. §103 over Li (US 2004/0089418) combined with Lloyd et al. and Sugino et al. or Bloch et al. Claim 27 has been rejected under 35 U.S.C. §103 over Li (US 2004/0089418) combined with Lloyd et al. and Sugino et al. or Bloch et al., and further in view of Schroeder. It is respectfully submitted that Li (US 2004/0089418) is not prior art against the present application.

Li (US 2004/0089418) published on May 13, 2004, which is after the March 16, 2004, filing date of the present application. Hence, Li (US 2004/0089418) cannot be prior art against the present application under 35 U.S.C. §102(a). In addition, Li (US 2004/0089418) and the

present application were, at the time the invention claimed in claims 1-12 and 19-30 was made, owned by, or subject to an obligation of assignment to, the State of Oregon acting by and through the Oregon State Board of Higher Education on behalf of Oregon State University. Accordingly, Li (US 2004/0089418) falls under the 35 U.S.C. §103(c)(1) exclusion from obviousness of potential 35 U.S.C. §§102(e), 102(f) and 102(g) prior art. In view of the foregoing, the pending 35 U.S.C. §103 rejections must be withdrawn.

Since the elected product claims 1-12 and 19-30 should be allowable, it is submitted that withdrawn process of use claims 13-16 and 31 should be rejoined in the present application pursuant to MPEP §821.04. An indication to this effect in a Notice of Allowance is respectfully requested.

It is submitted that the present application is now in condition for allowance. Should there be any questions regarding this application, examiner Rajguru is invited to contact the undersigned attorney at the telephone number shown below.

Respectfully submitted,

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